

REMARKS

The Office Action mailed April 24, 2009 has been received and reviewed. Prior to the present communication, claims 28 and 30-63 were pending in the subject application. Each of claims 28 and 30-63 stands rejected. Claims 28, 30, 33-34, 40-42, 45-46, 48, 52-55, 57-58, and 60 have been amended herein. As such, claims 28 and 30-63 remain pending. Care has been exercised to introduce no new subject matter. Applicants respectfully request reconsideration of the present Application in view of the above amendments and the following remarks.

Rejections based on 35 U.S.C. § 103

A) Applicable Authority

Title 35 U.S.C. § 103(a) declares that a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” In *Graham v. John Deere*, the Supreme Court counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. See *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP § 2141.02(I) (emphasis in original) (citing *StratoFlex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)).

“The examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness To reach a proper determination of obviousness, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. In view of all factual information, the examiner must then determine whether the claimed invention ‘as a whole’ would have been obvious at that time to that person. *Id* (emphasis added). Knowledge of applicant’s disclosure must be put aside in reaching this determination [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP § 2142.

“The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s)** why the claimed invention would have been obvious.” MPEP § 2142 citing *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007) (emphasis added), which notes that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.

B) Obviousness Rejection based on Dono and Pelon

Claims 28, 30-37, 40-49 and 52-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dono et al. (U.S. Patent No. 7,089,593, hereinafter the Dono reference) in view of Pelon (U.S. Publication No. 2004/0073567, hereinafter the Pelon reference). As the asserted combination of references fails to describe or suggest all of the elements set forth in claims 28, 30-37, 40-49, and 52-61, Applicants respectfully traverse these rejections as hereinafter set forth.

Independent claim 28, as currently amended, recites a method for creating a user profile. The method comprises detecting a connection of a Portable Storage Device (PSD) to a computing device. The method further comprises upon detecting the connection of the PSD, scanning the PSD for an indication of a stored user profile containing data files, application settings and user environment settings, wherein the user environment settings include one or more of a user's desktop configuration, a start menu configuration, or an application toolbar configuration. The method also comprises upon detecting that no user profile is stored on the PSD, automatically launching a user profile configuration wizard that enables the user to create a user profile on the PSD. Also upon detecting that no user profile is stored on the PSD, the method comprises receiving input from the user profile configuration wizard, wherein the input includes an instruction to synchronize a first data content item and an instruction to not synchronize a second data content item that is different from the first data content. Further upon detecting that no user profile is stored on the PSD, the method also comprises upon receiving the input from the user profile configuration wizard, automatically storing the first content item on the PSD in association with a new user profile. The method further comprises determining that the first data content item has been modified and based on the new user profile, automatically synchronizing the modified first data content item with the PSD. The method further comprises determining that the second data content item has been modified and based on the new user profile, not synchronizing the modified second data content item with the PSD. The method also comprises determining that one or more of the user environment settings associated with the new user profile has been modified and based on the new user profile, automatically synchronizing the user environment setting with the PSD.

Neither the Dono reference nor the Pelon reference describes or suggests, either alone or in combination, all of the steps of the method of claim 28, in particular: upon detecting that no user profile is stored on the PSD, automatically launching a user profile configuration wizard that enables the user to create a user profile on the PSD; upon detecting that no user profile is stored on the PSD, receiving input from the user profile configuration wizard, wherein the input includes an instruction to synchronize a first data content item and an instruction to not synchronize a second data content item that is different from the first data content; determining that the first data content item has been modified and based on the new user profile, automatically synchronizing the modified first data content item with the PSD; determining that the second data content item has been modified and based on the new user profile, not synchronizing the modified second data content item with the PSD; and determining that one or more of the user environment settings associated with the new user profile has been modified and based on the new user profile, automatically synchronizing the user environment setting with the PSD.

The Dono reference describes a method for providing temporary access to a commonly accessible computer processing system. In the method of the Dono reference, the coupling of a portable storage device to a commonly accessible computer processing system (CA computer) is detected. *See* Dono reference at Abstract. The CA computer then checks the portable storage device for an access code to determine if the user is authorized to access the CA computer. *Id.* After the user is signed in, the user's personalization information is read from the portable storage device. *See* Dono at col. 6, ll. 45-49. The user personalization information includes application settings and desktop appearance settings. *See* Dono at col. 4, ll. 16-31.

As conceded in the Office Action, the Dono reference, however, does not describe several claim elements of currently amended independent claim 28. Specifically, the Dono reference does not describe or suggest upon detecting that no user profile is stored on the PSD, automatically launching a user profile configuration wizard that enables the user to create a user profile on the PSD. The Dono reference also does not describe or suggest upon detecting that no user profile is stored on the PSD, receiving input from the user profile configuration wizard, wherein the input includes an instruction to synchronize a first data content item and an instruction to not synchronize a second data content item that is different from the first data content. Further, the Dono reference does not describe or suggest determining that the first data content item has been modified and based on the new user profile, automatically synchronizing the modified first data content item with the PSD. The Dono reference also does not describe or suggest determining that the second data content item has been modified and based on the new user profile, not synchronizing the modified second data content item with the PSD. The Dono reference also does not describe or suggest determining that one or more of the user environment settings associated with the new user profile has been modified and based on the new user profile, automatically synchronizing the user environment setting with the PSD.

The Pelon reference is cited for curing the deficiencies of the Dono reference. The Pelon reference, however, fails to describe or suggest the claim elements not described or suggested by the Dono reference. The Pelon reference describes a method of storing databases in a portable computer using an improved method of interchanging data records. *See* Pelon reference at Abstract. The method of the Pelon reference allows optimization of storage space requirements while ensuring accessibility to user-required data. *See, e.g.*, Pelon reference at pars. [0009] and [0013]. Data records and fields from a master database can be selectively

downloaded into a portable computer depending on whether they are needed. *Id.* According to the method described in the Pelon reference, when the portable computer is remote from the main system, upon activation of a database program a user is presented with options to create a new database, create or modify records in an existing database, and prepare reports. *See* Pelon reference at par. [0097]. This portion of the Pelon reference is cited for describing upon detecting that no user profile is stored on the PSD, automatically launching a user profile configuration wizard that enables the user to create a user profile on the PSD in currently amended independent claim 28. Creating a new database is not the same as launching a user profile configuration wizard. As detailed in claim 28, a user profile contains data files, application settings, and user environment settings, wherein the user environment settings include one or more of a user's desktop configuration, a start menu configuration, or an application toolbar configuration. The database described in the Pelon reference can be customized by specifying data fields, data formats, and the like. *See* Pelon reference at par. [0098]. The database of the Pelon reference does not contain application settings or user environment settings.

Further, in currently amended independent claim 28, it is first detected that no user profile is stored on the portable storage device. In the Pelon reference, the absence of a database is not detected – the user is only presented with options to create a new database or modify an existing database. The Pelon reference does not describe or suggest detecting that no user profile exists and then automatically launching a user profile configuration wizard.

Additionally, the Pelon reference does not describe or suggest upon detecting that no user profile is stored on the PSD, receiving input from the user profile configuration wizard, wherein the input includes an instruction to synchronize a first data content item and an

instruction to not synchronize a second data content item that is different from the first data content. As discussed above, the Pelon reference does not describe or suggest a user profile configuration wizard. The Pelon reference also does not describe receiving an instruction to synchronize a first data content item and an instruction to not synchronize a second data content item. Paragraph [0100] of the Pelon reference is cited for describing this claim element, but paragraph [0100] simply describes general synchronization of the portable computer with the master database. The Pelon reference does not describe the ability to select that a first data content item be synchronized and select that a second data content item will not be synchronized.

The Pelon reference also does not describe or suggest determining that the first data content item has been modified and based on the new user profile, automatically synchronizing the modified first data content item with the PSD. Further, the Pelon reference does not describe or suggest determining that the second data content item has been modified and based on the new user profile, not synchronizing the modified second data content item with the PSD. In these steps of the method of currently amended independent claim 28, after a user has already selected that a first data content item be synchronized and a second data content item not be synchronized, changes to the first and second data content items will be treated accordingly. Thus, if a change is made to the second data content item, the change will not be synchronized because the user has selected that it not be synchronized when the user profile was created. Again, the Pelon reference merely describes general synchronization of databases.

Additionally, the Pelon reference also does not describe or suggest determining that one or more of the user environment settings associated with the new user profile has been modified and based on the new user profile, automatically synchronizing the user environment setting with the PSD. The Pelon reference only discusses synchronization of databases – it does not describe or suggest determining that a user environment setting has been modified, and according to the choice made in the creation of the user profile, automatically synchronizing the user environment setting with the portable storage device.

The asserted combination of the Dono and Pelon references fails to describe or suggest all of the elements set forth in currently amended independent claim 28. Accordingly, the invention of currently amended independent claim 28 would not have been obvious to one having ordinary skill in the art at the time of invention. Therefore, withdrawal of the obviousness rejection and allowance of amended independent claim 28 are respectfully requested.

Claims 30-37 depend on independent claim 28, which is submitted to be allowable for the reasons indicated above. As a result, the inventions of dependent claims 30-37 would not have been obvious to one having ordinary skill in the art at the time of invention. Therefore, withdrawal of the obviousness rejection and allowance of dependent claims 30-37 are respectfully requested.

Independent claim 40, as currently amended, recites a computer readable storage medium on which is stored computer executable instructions that cause a computer to perform a method for creating a user profile. The method comprises detecting a connection of a Portable Storage Device (PSD) to a computing device. The method further comprises upon detecting the connection of the PSD, scanning the PSD for an indication of a stored user profile containing

data files, application settings and user environment settings that are used to configure the computing device. The method also comprises upon detecting that no user profile is stored on the PSD, automatically launching a user profile configuration wizard. Also upon detecting that no user profile is stored on the PSD, the method comprises receiving input from the user profile configuration wizard, wherein the input includes an instruction to synchronize a first data content item and an instruction to not synchronize a second data content item that is different from the first data content item. Further upon detecting that no user profile is stored on the PSD, the method also comprises upon receiving the input from the user profile configuration wizard, automatically storing the first data content item on the PSD in association with a new user profile. The method also comprises determining that the first data content item has been modified and based on the new user profile, automatically synchronizing the modified first data content item with the PSD. The method further comprises determining that the second data content item has been modified and based on the new user profile, not synchronizing the modified second data content item with the PSD.

The Dono and Pelon references are discussed in detail above. Also as discussed above, neither the Dono reference nor the Pelon reference describes or suggests, either alone or in combination, all of the elements of currently amended independent claim 40, in particular: upon detecting that no user profile is stored on the PSD, automatically launching a user profile configuration wizard; upon detecting that no user profile is stored on the PSD, receiving input from the user profile configuration wizard, wherein the input includes an instruction to synchronize a first data content item and an instruction to not synchronize a second data content item that is different from the first data content item; upon detecting that no user profile is stored on the PSD and upon receiving the input from the user profile configuration wizard,

automatically storing the first data content item on the PSD in association with a new user profile; determining that the first data content item has been modified and based on the new user profile, automatically synchronizing the modified first data content item with the PSD; and determining that the second data content item has been modified and based on the new user profile, not synchronizing the modified second data content item with the PSD.

The asserted combination of the Dono and Pelon references fails to describe or suggest all of the elements set forth in currently amended independent claim 40. Accordingly, the invention of amended independent claim 40 would not have been obvious to one having ordinary skill in the art at the time of invention. Therefore, withdrawal of the obviousness rejection and allowance of amended independent claim 40 are respectfully requested.

Claims 41-49 depend on independent claim 40, which is submitted to be allowable for the reasons indicated above. As a result, the inventions of dependent claims 41-49 would not have been obvious to one having ordinary skill in the art at the time of invention. Therefore, withdrawal of the obviousness rejection and allowance of dependent claims 41-49 are respectfully requested.

Independent claim 52, as currently amended recites a computer comprising a processor and a memory including computer executable instructions that cause the computer to perform a method for creating a user profile. The method comprises detecting a connection of a Portable Storage Device (PSD) to a computing device. The method further comprises upon detecting the connection of the PSD, scanning the PSD for an indication of a stored user profile containing data files, application settings, and user environment settings that are used to configure the computing device. The method also comprises upon detecting that no user profile is stored on the PSD, automatically launching a user profile configuration wizard. Also upon

detecting that no user profile is stored on the PSD, the method comprises receiving input from the user profile configuration wizard, wherein the input includes an instruction to synchronize a first data content item and an instruction to not synchronize a second data content item that is different from the first data content item. Further upon detecting that no user profile is stored on the PSD, the method also comprises upon receiving the input from the user profile configuration wizard, automatically storing the first data content item on the PSD in association with a new user profile. The method also comprises determining that the first data content item has been modified and based on the new user profile, automatically synchronizing the modified first data content item with the PSD. The method further comprises determining that the second data content item has been modified and based on the new user profile, not synchronizing the modified second data content item with the PSD.

The Dono and Pelon references are discussed in detail above. Also as discussed above, neither the Dono reference nor the Pelon reference describes or suggests, either alone or in combination, all of the elements of currently amended independent claim 52, in particular: upon detecting that no user profile is stored on the PSD, automatically launching a user profile configuration wizard; upon detecting that no user profile is stored on the PSD, receiving input from the user profile configuration wizard, wherein the input includes an instruction to synchronize a first data content item and an instruction to not synchronize a second data content item that is different from the first data content item; upon detecting that no user profile is stored on the PSD and upon receiving the input from the user profile configuration wizard, automatically storing the first data content item on the PSD in association with a new user profile; determining that the first data content item has been modified and based on the new user profile, automatically synchronizing the modified first data content item with the PSD; and

determining that the second data content item has been modified and based on the new user profile, not synchronizing the modified second data content item with the PSD.

The asserted combination of the Dono and Pelon references fails to describe or suggest all of the elements set forth in currently amended independent claim 52. Accordingly, the invention of amended independent claim 52 would not have been obvious to one having ordinary skill in the art at the time of invention. Therefore, withdrawal of the obviousness rejection and allowance of amended independent claim 52 are respectfully requested.

Claims 53-61 depend on independent claim 52, which is submitted to be allowable for the reasons indicated above. As a result, the inventions of dependent claims 53-61 would not have been obvious to one having ordinary skill in the art at the time of invention. Therefore, withdrawal of the obviousness rejection and allowance of dependent claims 53-61 are respectfully requested.

C) Obviousness Rejection based on Dono, Pelon, and Horvitz

Claims 38, 39, 50, 51, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dono and Pelon and further in view of Horvitz (U.S. Publication No. 2003/0154282, hereinafter Horvitz). As the asserted combination of references fails to describe or suggest all of the elements set forth in claims 28, 30-37, 40-49 and 52-61, Applicants respectfully traverse these rejections as hereinafter set forth.

Claims 38-39 depend from currently amended independent claim 28, which is submitted to be allowable and nonobvious, as discussed above. The Horvitz reference is cited for additional elements found in dependent claims 38-39. The Horvitz reference, however, does not describe or suggest the elements of currently amended independent claim 28, on which claims 38-39 depend, that were not described by the Dono and Pelon references.

The Horvitz reference describes a resource download process including accepting and/or determining evidence about user based factors, accepting and/or determining resource based factors, and maximizing the expected value of downloading resources. *See* Horvitz reference at Abstract. The Horvitz reference is cited for claim limitations describing determining whether there is sufficient memory available on the PSD to store a user profile and if there is sufficient memory available, selecting a portion of memory on the PSD for storing the user profile and formatting the portion of memory for use as a user profile. The Horvitz reference is also cited for describing, along with the ordinary skill in the art, if insufficient memory is available on the PSD to store a user profile, offering to free up storage space on the PSD by deleting files stored on the PSD. The Horvitz reference still does not describe the portions of currently amended independent claim 28 as discussed in detail above in section B).

The asserted combination of the Dono, Pelon, and Horvitz references fails to describe or suggest all of the elements set forth in currently amended independent claim 28. As such, the invention of currently amended independent claim 28 would not have been obvious to one having ordinary skill in the art at the time of invention. Because dependent claims 38-39 depend directly from currently amended independent claim 28, the inventions of dependent claims 38-39 would also not have been obvious to one having ordinary skill in the art at the time of invention. Therefore, withdrawal of the obviousness rejection and allowance of dependent claims 38-39 are respectfully requested.

Claims 50-51 depend from currently amended independent claim 40, which is submitted to be allowable and nonobvious, as discussed above. The Horvitz reference is cited for additional elements found in dependent claims 50-51. As discussed above, the Horvitz reference, however, does not describe or suggest the elements of currently amended independent

claim 40, on which claims 50-51 depend, that were not described by the Dono and Pelon references.

Because the asserted combination of the Dono, Pelon, and Horvitz references fails to describe or suggest all of the elements set forth in currently amended independent claim 40, the invention of currently amended independent claim 40 would not have been obvious to one having ordinary skill in the art at the time of invention. Because dependent claims 50-51 depend directly from currently amended independent claim 40, the inventions of dependent claims 50-51 would also not have been obvious to one having ordinary skill in the art at the time of invention. Therefore, withdrawal of the obviousness rejection and allowance of dependent claims 50-51 are respectfully requested.

Claims 62-63 depend from currently amended independent claim 52, which is submitted to be allowable and nonobvious, as discussed above. The Horvitz reference is cited for additional elements found in dependent claims 62-63. As discussed in detail above, the Horvitz reference, however, does not describe or suggest the elements of currently amended independent claim 52, on which claims 62-63 depend, that were not described by the Dono and Pelon references.

Because the asserted combination of the Dono, Pelon, and Horvitz references fails to describe or suggest all of the elements set forth in currently amended independent claim 52, the invention of currently amended independent claim 52 would not have been obvious to one having ordinary skill in the art at the time of invention. Because dependent claims 62-63 depend directly from currently amended independent claim 52, the inventions of dependent claims 62-63 would also not have been obvious to one having ordinary skill in the art at the time of invention.

Therefore, withdrawal of the obviousness rejection and allowance of dependent claims 62-63 are respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 28 and 30-63 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or cduncan@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

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